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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,062	03/28/2001	Mary Smiley	42390P10856	4052

8791 7590 08/15/2005

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EXAMINER

LAYE, JADE O

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/820,062

**Applicant(s)**

SMILEY ET AL.

**Examiner**

Jade O. Laye

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

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### *Response to Arguments*

1. Applicant's amendments and arguments filed 6/10/05 have been entered and fully considered, respectively, but they are unpersuasive. Accordingly, **THIS ACTION IS MADE FINAL.**

Applicant argues that *Carr* does not appear to teach claim 1's recited "converting the enhancement data" and "providing said converted enhancement data to a client." (Applicant's Response, Pg. 12). The Office does not agree. At Paragraph [0025], *Carr* discloses that the A/V data and enhancement data can be separated at the transport operator system 14, with the A/V content being transmitted over a different transport medium than the corresponding enhancement data. When the data is separated at the transport operator system 14, it is being "converted" into a different format, which is compatible with the respective transport mediums 20 and 22 and subsequently received by the end-user. Therefore, *Carr* does in fact teach "converting said enhancement data" and "providing said converted enhancement data to a client."

In an effort to clarify the inventive intent in the claims, Applicant narrowly amended claims 1, 9, 14, 20, and 22 to include receiving enhancement data by a receiver "not configured to process enhancement data." However, Applicant has failed to clarify this distinction because the Examiner is unable to find support and/or an explanation in the Specification for the proposed clarification. Moreover, the plain language of Applicant's Claim 2 contradicts such a distinction. Claim 2 recites limitations that address "receiving the television broadcast" and "extracting said enhancement data from the television broadcast." Therefore, how can

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Applicant's system "extract" enhancement data" as recited in Claim 2, while at the same time, the system is "not configured to process enhancement data" as recited in Claim 1? "Extracting" data is a form of "processing" data. Therefore, Applicant's amendment has only rendered the claims more confusing and, as will be applied below, the Examiner is applying a rejection under 35 U.S.C. 112.

Applicant also argues against the overbroad generalization stating "Claims 9, 14, 17, 20, and 22 correspond to the method claim 1. The Examiner agrees in part and disagrees in part. Claim 14 does recite a "central site for providing the enhancement data," which was not specifically addressed in the previous Non-Final Action. However, the Examiner failed to address this limitation because it was obvious in light of the cited portions of *Carr*. For clarification, Applicant need only refer to Figure 1A and the remainder of the cited portions in the previous action. The Examiner considers "transport operator 14" to read upon Applicant's "central site." Therefore, Claim 14 is encompassed within the limitations of Claim 1, and can also be rejected under the same citations used to reject Claim 1. The Examiner maintains that the remainder of the Claims correspond too or are encompassed by Claim 1.

Applicant goes on to argue that *Carr* fails to teach the push environment of Claim 4 or the pull environment of Claim 5. (Applicant's Response, Pg. 13). The Examiner finds this argument unpersuasive because Applicant fails to effectively advocate this position. For example, in support of this argument, Applicant only states "Pushing and pulling content is different than simply receiving broadcast content." (Pg. 13). However, Applicant does not expound upon what he or she considers to be "pushing" or "pulling," nor does Applicant's

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Specification detail or explain such terms. Accordingly, the Examiner can only maintain the position of the previous Non-Final Action.

Lastly, Applicant argues that the subject matter of the present invention and the *Carr* reference were both commonly assigned at the time of Applicant's invention. Applicant goes on to provide a very informative recitation of 35 U.S.C. 103(c) and states that, accordingly, "*Carr* is not a valid prior art" for these rejections. (Applicant's Response, Pg. 14). However, Applicant has failed to recognize the fundamental flaw in his or her argument: The present application and the *Carr* reference were not commonly owned at the time of Applicant's invention. According to USPTO Reel/Frame 0011927/0084, the execution date of the Intel Assignment of the present invention was 4/27/01, which is approximately one month after Applicant's filing date of 3/28/01. Therefore, at the time of Applicant's invention (3/28/01), there was no common assignment of the present invention and the *Carr* reference, thus Applicant is not qualified for 103(c) immunity. *[A copy of the Reel/Frame is provided for Applicant's review].*

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of *Carrying* out his invention.

2. Claims 1-5, 9-12, 14-18, 20, and 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For an explanation of the Examiner's position, please refer to the response section above.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 6-8, 13, 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by *Reynolds et al.* (US Pat. Pub. No. 2002/0138852).

As to claim 6, *Reynolds et al* disclose a system capable of transcoding media and associated content (i.e., enhancement data) into a format which is compatible with the transport network and delivering said media/associated content to a client. *Reynolds* goes on to teach the system is capable of analyzing the client side receiver capabilities in order to determine what transmission format should be utilized. (Abstract; Paragraphs [0003-0007, 0013]). This, in essence, forms part of a user profile because each user could have different receiver capabilities. Accordingly, *Reynolds et al* anticipate each and every limitation of Claim 6.

Claim 19 corresponds to the method claim 6. Thus, it is analyzed and rejected as previously discussed.

*[Note: Reynolds was applied under a 103 rejection in the previous Non-Final Action. Due to Applicant's amendments, Reynolds can now be applied under a 102. However, Applicant should recognize the Examiner still considers Carr to be an applicable reference. Reynolds is now being applied because it makes for a cleaner rejection.]*

As to claim 7, *Reynolds* further teaches that pricing information can be associated with various delivery formats and thus, used as a basis for selecting said format. (Paragraphs [0020, 0030, 0041]). Therefore, the combined systems of *Carr* and *Reynolds* contain all limitations of claim 7.

Claim 8 corresponds to the method claim 7. Thus, it is analyzed and rejected as previously discussed.

As to Claim 13, *Reynolds* further teaches the system transmits Java-type, JavaScript-type, audio/video streams, and HTML formats (i.e., tag based). ([0020 & Table 1]). Moreover, HTML is a markup language used to create web pages (i.e., web page format). Accordingly, *Reynolds et al* anticipate each and every limitation of Claim 13.

Claim 21 corresponds to the method claim 13. Thus, it is analyzed and rejected as previously discussed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye  
August 5, 2005.

  
NGOC-YEN VU  
PRIMARY EXAMINER